UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,594	05/03/2002	Dan L. Eaton	10466/360	2707

9157 7590 07/13/2004

GENENTECH, INC.
1 DNA WAY
SOUTH SAN FRANCISCO, CA 94080

EXAMINER	
WEGERT, SANDRA L	
ART UNIT	**PAPER NUMBER**
1647	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/063,594	EATON ET AL.	
	Examiner	Art Unit	
	Sandra Wegert	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-13* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *5/3/02* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/13/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Status of Application, Amendments, and/or Claims

The Preliminary Amendment, submitted 9 September 2002 and the Information Disclosure Statement, submitted 13 September 2002, have been entered.

Claims 1-13 are under examination in the Instant Application.

Informalities

Specification

The disclosure is objected to because of the following informalities:

URL's

The disclosure is objected to because it contains browser-executable code. This occurs, for example, in paragraph 205. All URL's should be removed from the Specification. Applicant may refer to web sites by non-executable name only. See MPEP § 608.01 (p).

Appropriate correction is required.

Continuity

This application claims priority to the following patent applications: US provisional application 60/097971, PCT/US99/12252, US application 09/380137, PCT/US00/23328 and US application 10/006,867. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: Provisional and parent patent applications 60/097971, PCT/US99/12252, US application 09/380137, listed in the first paragraph of the instant specification do not list or refer to: SEQ ID NO: 88, PRO1270, or Figure

88. Furthermore, parent applications do not describe or disclose data that would impart Utility to the instant invention; as well, the instant Invention lacks Utility. Therefore, for this Office Action, the filing date of 3 May 2002 is considered as the priority date.

Claim Rejections/Objections

Claim Rejections - 35 USC § 101 and 35 USC § 112, first paragraph

The following is a quotation of 35 U.S.C. 101:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention lacks a credible, specific and substantial asserted utility or a well-established utility.

The claims are directed to a polypeptide of 392 amino acids (see Figure 88). Further claim limitations are presented to isolated polypeptides having at least 80-99% sequence identity to the polypeptide of SEQ ID NO: 88, chimeric polypeptides based on SEQ ID NO: 88, and the polypeptide of SEQ ID NO: 88 lacking its associated signal peptide. However, the specification does not disclose a function for the polypeptide of SEQ ID NO: 88 in the context of the cell or organism.

No well-established utility exists for newly isolated complex biological molecules. However, the specification asserts the following as credible, specific and substantial patentable utilities for the claimed polypeptide encoded by the claimed polynucleotide:

1) To produce the PRO1270 polypeptide and fragments.

2) To produce a variant polypeptide.

3) For use in receptor localization.

4) In assays to screen for compounds capable of modifying the interaction between receptor and ligand.

5) To make antibodies to the polypeptide encoded by the polynucleotide of SEQ ID NO: 88.

6) In tissue typing.

7) To detect and treat cancer (paragraph 491).

Each of these shall be addressed in turn:

1*) To produce the PRO1270 polypeptide and fragments.* This asserted utility is not specific. Many nucleotide sequences can be used to make polypeptides. However, if the specification discloses nothing specific and substantial about the polynucleotides or polypeptides, both the polynucleotides and polypeptides produced have no patentable utility.

2) To produce a variant polypeptide. This asserted utility is not specific. Such assays can be performed with any polynucleotide. Further, the specification discloses nothing specific or substantial for the variant nucleotide and polypeptide that is produced by this method. Since

this asserted utility is also not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

3) For use in receptor localization. This asserted utility is credible, but it is not specific. Ligands and antibodies can be used to detect binding partners of the claimed polypeptide, and thus the asserted utility is not specific. Further, the specification does not disclose specific receptor targets. Since this asserted utility is not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

4) In assays to screen for compounds capable of modifying the interaction between receptor and ligand. This asserted utility is not specific. Such can be performed for any receptor-ligand pair. Additionally, the specification discloses nothing specific or substantial for the compounds that can be identified by this method.

5) To make antibodies to the polypeptide encoded by the polynucleotide of SEQ ID NO: 88. This asserted utility is not specific. Antibodies can be made to any polypeptide. However, if the specification discloses nothing specific and substantial about the polypeptide, the polypeptide, the polynucleotide encoding the polypeptide and antibodies have no patentable utility.

6) *In tissue typing.* This asserted utility is not specific. Such assays can be performed with any polypeptide encoded by a polynucleotide; thus, the asserted utility is not specific. Furthermore, the specification discloses a wide range of tissues that express the PRO1270 polypeptide. Applicants imply that this expression pattern supports a useful function for the PRO1270 polypeptide. However, patentable utility of tissue typing for the claimed polynucleotide encoding the PRO1270 polypeptide is not substantial, because one skilled in the

art would not readily use the nucleotide sequences for tissue-typing in a real world sense as the protein is not specific to one tissue and is not associated with any disease or disorder. This asserted utility is also not specific because numerous unrelated nucleotide sequences would also show a similar tissue typing pattern. In addition, evidence of mere expression in a tissue is not tantamount to a showing of a role for the polynucleotide of the present invention. It is not clear if expression of the polynucleotide of the present Invention is correlated with a specific change in physiology, for example, or with a disease state. Since this asserted utility is also not present in mature form, so that it could be readily used in a real world sense, the asserted utility is not substantial.

7) To detect and treat cancer. Paragraphs 491 of the instant Specification set forth the results of assays to determine the expression of clone DNA66308-1537 in tissues:

"Molecule is more highly expressed in: as compared to: DNA66308-1537 normal lung /lung tumor"

However, a slight increase or decrease in clone copies in tumors is not indicative of a specific or substantial utility for PRO1270 for use as an agent to detect or treat cancer. A slight increase in copy numbers of nucleic acids encoding PRO1270 in a cancerous tissue is more likely due to an increased number of chromosomes, a very common characteristic of cancerous and non-cancerous epithelial cells (see, for example: Hittelman, W., 2001, Ann. NY. Acad. Sci., 952: 1-12, especially pages 8 and 9, and; Crowell, et al, 1996, Cancer Epidemiol. 5: 631-637), not because PRO1270 is a target for therapeutic intervention in certain cancers. The asserted utility is therefore not substantial. Experiments confirming the specificity and substantial utility

of PRO1270 in terms of mRNA and protein expression were not performed. Significant further experimentation would be required of the skilled artisan to determine whether PRO1270 is expressed in certain cancers to the extent that antagonists (e.g., antibodies) directed against the protein encoded by DNA66308-1537 (PRO1270) would be expected to have utility in cancer therapy. Thus, the asserted utility is not substantial.

Claims 1-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Applicants have implied that the PRO1270 polypeptide is a secreted protein, possibly related to lectins (paragraph 491), that can be used to diagnose or treat cancer. One should keep in mind that function cannot be predicted based on structural similarity to proteins found in the sequence databases. Examples from the secreted polypeptide art demonstrate, in some cases, polypeptides with high homology having a wide-variety of functions in organisms (see Hesselgesser, et al, 1997, Methods in Enzymology, 287: 59-69, see pages 59 and 64-66) and in other cases, many different possible structures for secreted proteins that are considered related as to function (Blease, et al, 2000, Resp. Res., 1(1): 54-61). However, Applicants have not associated the disclosed PRO1270 polypeptide with any type or genus of secreted peptide.

Furthermore, the results of the experimental assays are not considered substantial because it is known in the art that increased mRNA levels do not necessarily correlate to an increase in protein production, or do not correlate well. For instance, Haynes et al.

(Electrophoresis, 1998, 19: 1862-1871) studied 80 proteins relatively homogenous in half-life and expression level, and found no strong correlation between protein and transcript levels for some genes. Equivalent RNA levels translated into changes in protein concentrations which varied by more than 50 fold. Haynes et al concluded that the protein levels cannot be accurately predicted from the levels of the corresponding mRNA transcripts (see page 1863, the second paragraph of the left column, and Figure 1). Further, even if the increased lectin mRNA correlates to an increase in lectin protein production, it is still unclear the biological significance of PRO1270 and lectin-like proteins in cancer cell proliferation (paragraph 491). The specification fails to provide evidence to illustrate the relationship between PRO1270 polypeptide and a positive change cancer cell proliferation, which would support the assertion that PRO1270 may be useful for therapeutic treatment. As many proteins may regulate the PRO1270 peptide, one cannot extrapolate from increased lectin levels that any protein, such as PRO1270, would be a useful target for treating cancer.

Therefore, based on the discussions above concerning the specific examples of structurally similar proteins that have different functions, along with the art's recognition that one cannot rely upon structural similarity alone to determine functionality, the specification fails to teach the skilled artisan how to use the claimed antibodies against PRO1270 without resorting to undue experimentation to determine what the specific biological activities of the PRO1270 polypeptide are.

The specification does not teach the skilled artisan how to use the claimed antibodies directed to the polypeptide of SEQ ID NO: 88 for any purpose. For example, there is no

disclosure of particular disease states correlating to an alteration in levels or forms of the polypeptide such that the claimed antibody could be used as a diagnostic tool. The skilled artisan is not provided with sufficient guidance to use the claimed antibodies for any purpose.

Furthermore, the specification does not reasonably provide enablement for the scope of all *variants* of the PRO1270 polypeptide. The disclosure does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification discloses the peptide of SEQ ID NO: 88. Claims 12 and 13 recite chimeric polypeptides in which the peptide of SEQ ID NO: 88 is modified. However, the specific activities of the protein of SEQ ID NO: 88, and assays to test for its activity, are not disclosed. There is no discussion, or working examples disclosed in the instant case, as to what amino acids are necessary to maintain the functional characteristics of the claimed PRO1270 polypeptides. The instant case claims altering much of the claimed polypeptide. However, the art shows that receptor families have members with high structural similarities but disparate functions. For example, Smith et al. (1997, Nature Biotechnology 15: 1222-1223) demonstrate that there are numerous cases in which proteins having very different functions share structural similarity due to evolution from a common ancestral gene. Brenner (1999, Trends in Genetics 15:132-133) argues that accurate inference of function from homology must be a difficult problem since, assuming there are only about 1000 major gene superfamilies in nature, then most homologs must have different molecular and cellular functions. Therefore, it is not predictable as to which amino acids are necessary to maintain the functional characteristics of a protein.

Due to the large quantity of experimentation necessary to determine an activity or property of the claimed polypeptide, such that it can be determined how to use the polypeptide of SEQ ID NO: 88 and to screen for activity, the lack of direction/guidance presented in the specification regarding same, the absence of working examples directed to same, the complex nature of the invention, the state of the prior art establishing that biological activity cannot be predicted based on structural similarity, and the unpredictability of the effects of mutation on protein structure and function, and the breadth of the claims which fail to recite particular biological activities- undue experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope.

35 USC § 112, first paragraph – Written Description.

Claims 1-6, 8-10 and 11-13 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The claims are directed to a polypeptide of 392 amino acids (see Figure 88). Further claim limitations are presented to isolated polypeptides having at least 80-99% sequence identity to the polypeptide of SEQ ID NO: 88, chimeric polypeptides based on SEQ ID NO: 88, and the polypeptide of SEQ ID NO: 88 lacking its associated signal peptide. However, the specification

does not disclose a function for the polypeptide of SEQ ID NO: 88 in the context of the cell or organism.

The specification teaches a polypeptide (SEQ ID NO: 88). However, the specification does not teach functional or structural characteristics of all claimed polypeptides. The description of one PRO polypeptide (SEQ ID NO: 88) is not adequate written description of an entire genus of functionally equivalent polypeptides.

To provide evidence of enablement of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include: disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed"* (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-Cath* at page 1116).

With the exception of the sequences referred to above, the skilled artisan cannot envision the detailed chemical structure of all claimed and encompassed PRO polypeptides, and therefore, would not know how to use them. Conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of use. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of use. The product itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only an isolated nucleic acid molecule comprising the nucleotide sequence of SEQ ID NO: 87 and a polypeptide comprising the amino acid sequence of SEQ ID NO: 88, but not the full breadth of the claims, meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

35 USC § 112, first paragraph – Deposit Rules

Claims 1-13 are also rejected under 35 U.S.C. § 112, first paragraph, as not complying with the enablement requirement. The invention appears to employ novel nucleic acid molecules (i.e., clone: *DNA66308-1537*). Since the nucleic acid molecules are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or

otherwise readily available to the public. If the nucleic acid molecules are not so obtainable or available, the requirements of 35 U.S.C. § 112 may be satisfied by a deposit of the nucleic acid molecules. The Specification at paragraph 420 indicates that the deposit was made under the Budapest treaty. However, Applicants have failed to provide a copy of the deposit receipt. If a deposit is made under the Budapest Treaty, then an affidavit or declaration by Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the specific nucleic acid molecules have been deposited under the Budapest Treaty and that the nucleic acid molecules will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. If a deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. §§ 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

(a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;

(d) a test of the viability of the biological material at the time of deposit will be made (see 37 C.F.R. § 1.807); and

(e) the deposit will be replaced if it should ever become inviable. Applicant's attention is directed to M.P.E.P. §2400 in general, and specifically to §2411.05, as well as to 37 C.F.R. §

1.809(d), wherein it is set forth that "the specification shall contain the accession number for the deposit, the date of the deposit, the name and address of the depository, and a description of the deposited material sufficient to specifically identify it and to permit examination.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-13 are rendered indefinite because of the phrase "extracellular domain." The metes and bounds of Claims 1-13 are indefinite in view of the instant Specification which implies and states that the polypeptide encoded by the claimed polynucleotide(s) is a secreted protein. Such an "extracellular domain" would be found in a cleaved transmembrane protein, for example, along with an intracellular domain, but is not recognized in secreted proteins since they are entirely "extracellular."

References

Additional References considered pertinent, but not cited in the current Office Action:

Tanigami, et al, 2003, Accession No., BAA90893.

Skolnick et al., 2000, Trends in Biotech. 18: 34-39.

Bork, P., 2000, Genome Research 10: 398-400.

Doerks et al., 1998, Trends in Genetics 14: 248-250.

Conclusion: Claims 1-13 are rejected for the reasons recited above.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Wegert whose telephone number is (571) 272-0895. The examiner can normally be reached Monday - Friday from 9:00 AM to 5:00 PM (Eastern Time). If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached at (571) 272-0961.

The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLW

7/4/04

Lorraine Spector

LORRAINE SPECTOR
PRIMARY EXAMINER